

REMARKS

Claim Revisions

Claim 1 has been amended to incorporate the recitations of claim 5, now cancelled. The other elected claims have been revised in like fashion, all without implicating any impermissible new matter. Entry of these changes therefore is requested.

Traversal of Election Requirements

(A) Election between Group I and Group II

The PTO has invoked MPEP § 806.05(h) to justify a restriction against the subject matter of the “nucleic acid sequence” claims of Group II. In fact, the recited sequences are related to the “transgenic plant” of various elected claims as combination to subcombination, thereby calling MPEP § 806.05(c) into play.

Pursuant to Section 806.05(c), a restriction is sustained only if “it can be shown that

- (A) a combination as claimed does not require the particulars of the subcombination as claimed for patentability, and
- (B) the subcombination can be shown to have utility either by itself or in another materially different combination.”

This section further states that, “[w]hen these factors cannot be shown, such inventions are not distinct.” At least as to factor (A), however, the present action does not make out a *prima facie* case for the patentability of the elected transgenic-plant claims *sans* the particulars of recited element that effects seed-specific expression.

For this reason alone, applicants request a withdrawal of the restriction requirement and the PTO's consideration of Group I and Group II claims together. In keeping with Section 806.05(c), moreover, the PTO examined expression-method claims, transgenic-plant claims, and nucleic acid-sequence claims together in the parent application, which issued as patent No. 6,777,591. Accordingly, applicants submit that it likewise should not be an undue burden for the examiner to consider all of the above-mentioned claims in the present application.

(B) Election among nucleic acid sequences

As noted, applicants have been required to elect one from among nucleic acid sequence from SEQ ID NOs: 1, 4, 6, and 8. Claims to SEQ ID NO: 8 issued out of the parent application.

The subject election apparently rests upon the premise that nucleotide "sequences encoding different promoter [*sic*] are structurally distinct chemical compounds and are unrelated to one another." Action at page 3, lines 7 and 8. This premise does not apply to the present claims, however, since all of the sequences relate to seed-specific promoters from flax that display unifying features.

In particular, the promoters share structural similarities by virtue of having an alternating purine-pyrimidine sequences (RY repeat) and an abscisic acid-responsive element (ABRE) with similar spacing. In addition, SEQ ID NO: 6 and SEQ ID NO: 8 have the four promoter elements in common -- EBOX (CANNTG element), abscisic acid-responsive element (ABRE), soybean embryo factor 3 (SEF3), alternating purine-pyrimidine sequences (RY repeat) -- and the order of the elements is maintained in both. The two oleosin promoters, SEQ ID NOs: 1 and 4, share the promoter elements RY repeat and CACGTG sequence, which has ABRE as a sub-set, and the order of the elements again is maintained.

Applicants submit, therefore, that the proffered rationale for this election requirement is erroneous in fact, warranting withdrawal of the requirement. Furthermore, the PTO has not shown how considering a mere three sequences in the present case could represent an undue burden, as against the undeniable burden on the assignee, a small biotech company, of having to pursue adequate protection via multiple applications. Expressly invoking the Commissioner's notice of November 19, 1996, therefore, applicants request that the examiner take up SEQ ID NOs: 1, 4, and 6 together in this prosecution.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 CFR §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by the credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

Respectfully submitted,

Date 11 October 2006

By Stephen A. Bent

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 672-5404
Facsimile: (202) 672-5399

Stephen A. Bent
Attorney for Applicant
Registration No. 29,768